

AF *Imw*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of

M. Chatani

Application No. 09/632,861

Filed: August 4, 2000

For: NETWORK-BASED METHOD AND SYSTEM  
FOR TRANSMITTING DIGITAL DATA TO  
A CLIENT COMPUTER AND CHARGING  
ONLY FOR DATA THAT IS USED BY THE  
CLIENT COMPUTER USER



Examiner: Abdi, K.

Art Unit: 3621

Docket No. SONYP002

Date: January 18, 2005

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on January 18, 2005.

Signed: \_\_\_\_\_

Kay Harlow

RESPONSE TO NOTICE OF NON-COMPLIANCE UNDER 37 CFR 1.192(C)

Commissioner for Patents  
Alexandria, VA 22313-1450

Dear Sir:

In response to this Notice, mailed on December 17, 2004, the Applicant hereby re-submits the entire Appeal Brief. The newly submitted Appeal Brief addresses the issues pointed out by the Examiner. Specifically, the Arguments in Sections C and D have been properly correlated to the pending claims under Appeal. Also, the Summary section of the Appeal Brief has been thoroughly annotated with reference citations to the as-filed Specification and Drawings.

The Applicant was given a one month to reply, which extends to January 18, 2004, as January 17, 2004 was a federal holiday.

This updated Appeal Brief (dated January 18, 2005) is being submitted in triplicate. The Applicant believes that no fees are due in the filing of this paper, but the Commissioner is authorized to charge any fees due to Deposit Account No. 50-0805 (Order No. SONYP002). If there are any questions regarding this request, please contact the undersigned attorney of record at the telephone number set forth below.

Respectfully submitted,  
MARTINE & PENILLA, LLP

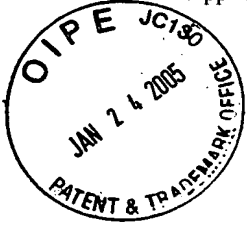
Albert S. Penilla, Esq.

Registration No. 39,487

710 Lakeway Drive, Suite 200  
Sunnyvale, CA 94085  
(408) 749-6900

**Customer No. 25920**

Attorney Docket No. SONYP002



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

---

**EX PARTE Chatani**

---

**Application for Patent**

**Filed: August 4, 2000**

**Application No. 09/632,861**

**FOR:**

**NETWORK-BASED METHOD AND SYSTEM FOR TRANSMITTING  
DIGITAL DATA TO A CLIENT COMPUTER AND CHARGING ONLY  
FOR DATA THAT IS USED BY THE CLIENT COMPUTER USER**

---

**APPEAL BRIEF**

---

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 18, 2005.

Signed: \_\_\_\_\_

  
Kay Harlow

**MARTINE & PENILLA, LLP  
Attorneys for Applicants**



## TABLE OF CONTENTS

	<u>Page No.</u>
I. REAL PARTY IN INTEREST .....	1
II. RELATED APPEALS AND INTERFERENCES .....	1
III. STATUS OF THE CLAIMS.....	1
IV. STATUS OF THE AMENDMENTS.....	1
V. SUMMARY OF THE INVENTION .....	1
VI. ISSUES.....	4
A. Are Claims 1-8 properly rejected under 35 U.S.C. §112, second paragraph?	
B. Are Claims, 9-12 and 17-24 properly rejected under 35 U.S.C. §112, second paragraph?	
C. Are Claims 1-8 properly rejected under 35 U.S.C. §103(a)?	
D. Are Claims 9-12 and 17-24 properly rejected under 35 U.S.C. §103(a)?	
VII. GROUPING OF THE CLAIMS .....	4
VIII. ARGUMENTS.....	4
A. The claimed invention is not indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention, as recited in claims 1-8 (Group I).....	4
B. The claimed invention is not indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention, as recited in claims 9-12 and 17-24 (Group I).....	7
C. The references relied upon by the Examiner, either separately or in combination, do not motivate or suggest to one of ordinary skill in the art at the time of the invention to combine the reference teachings in a manner that would make the invention as recited in Claims 1-8 (Group I) obvious.....	10
D. The references relied upon by the Examiner, either separately or in combination, do not motivate or suggest to one of ordinary skill in the art at	

**the time of the invention to combine the reference teachings in a manner that would make the invention as recited in Claims 9-12 and 17-24 (Group II) obvious.**

.....  
**17**

**E. Conclusion. .... 22**

APPENDIX A - CLAIMS ON APPEAL

**I. REAL PARTY IN INTEREST**

The real party in interest is Sony Computer Entertainment America Inc., the assignee of the present application.

**II. RELATED APPEALS AND INTERFERENCES**

The undersigned is not aware of any related appeals and/or interferences.

**III. STATUS OF THE CLAIMS**

A total of 24 claims were presented during prosecution of this application. Claims 13-16 were cancelled. The Applicants appeal rejected Claims 1-12 and 17-24.

**IV. STATUS OF THE AMENDMENTS**

All amendments have been entered, leaving finally rejected Claims 1-12 and 17-24, which are the appealed claims.

**V. SUMMARY OF THE INVENTION**

Broadly speaking, it is an object of embodiments of the present invention to provide a digital media distribution system that allows primary content providers to distribute media containing several different products and to charge customers for product that is actually used rather than the product that is distributed. (Page 4, lines 2-5).

The present invention also provides a system that allows content providers to provide both primary content as well as sample content on the same medium and charge customers based only on usage of the primary content. (Page 4, lines 6-8). In a further embodiment, the present invention provides a system that allows secure transmission of primary content data and prevents customer use of product that is not purchased. (Page 4, lines 9-11).

A flexible product distribution and payment system for computer network based electronic commerce is disclosed. Primary content data is made available to customers through a detachable local storage medium, such as a DVD or CD-ROM disc, or over a network connection. The primary content is capable of being accessed and played back through a computer or game console at the customer site. The primary content distribution may comprise a superset of content that is intended to be used by the customer. The customer is allowed to view and access the encoded primary content, and is charged only for the primary content that is used. Content that is encoded on the medium but that is not used by the customer remains on the medium but is not charged. A content database and customer database maintained at the primary customer site maintain records of products ordered and used by the customer, as well as identification and use patterns associated with the user. Authentication and use trigger data associated with the distributed content alert the primary content server computer when customer use has occurred and when a charge to the customer is appropriate. (Page 4, lines 12-23, and page5, lines 1-2, and Figure 1).

In a further embodiment, a system for providing access to primary media content in digital form is provided. The system includes a server network comprising a download management server, a customer database storing user information, and a primary content database storing primary media content. (Page 9, lines 1-15). A client console connectable for establishing a communications link through a bi-directional communications network to said download management server is further provided, and the client console stores user specific information. (Page 14, lines 3-12, Page 17, lines 18-20, Page 18, lines 1-7, and page 20- lines 1-9). A detachable storage media installable in said client console is also included. (Page 10, lines 13). The detachable storage media has a

media identifier, wherein the media identifier is combined with the user specific information to define a user identifier, and the user identifier is uploaded to said download management server to enable access only to a specified content in said primary media content database. (Page 14, lines 3-20, and Page 17, lines 8-20). The specified content and said user information is downloaded to said client console, and the specified content is associated with billing trigger data to enable monitoring of when specific portions of the specified content is accessed for use at said client console. (Page 20, lines 1-9, Page 15, lines 20-23, Page 16, lines 1-14, and Figures 4-6). The monitoring is configured to generate a record of used content, and the record of used content is communicated back to the management server to record a revenue bearing event in the customer database. (Page 16, lines 4-7).

Other embodiments are provided by reference to the claims, and the Board is respectfully referred to the figures of the invention for a complete understanding of what the Applicant regards as the invention.

## VI. ISSUES

The issues presented in this appeal are related to rejections under 35 U.S.C. 112, second paragraph, and rejections under 35 U.S.C. §103(a). The issues therefore are as follows:

- A. Are Claims 1-8 properly rejected under 35 U.S.C. §112, second paragraph?
- B. Are Claims, 9-12 and 17-24 properly rejected under 35 U.S.C. §112, second paragraph?
- C. Are Claims 1-8 properly rejected under 35 U.S.C. §103(a)?
- D. Are Claims 9-12 and 17-24 properly rejected under 35 U.S.C. §103(a)?

## VII. GROUPING OF THE CLAIMS

Applicants propose two groups of claims. The claims within each group will stand or fall together. The first group includes Claims 1-8 ("Group I") Group I is addressed in Argument Sections A and C. The second group includes Claims 9-12 and 17-24 ("Group II"). Group II is addressed in Argument Sections B and D. Each group will be argued separately.

## VIII. ARGUMENTS

- A. **The claimed invention is not indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention, as recited in claims 1-8 (Group I).**

### **Rejection:**

Claims 1-8 were rejected as being indefinite, under the second paragraph of Section 112. Citing from claim 1, the Examiner notes that the language "...to enable access only to a specified content in said primary media content database..." is not clear



because the Examiner does not understand how the specified content is identified within the primary media content database. See Advisory Action dated Aug. 17, 2004.

**The Claim language:**

Language of Claim 1.

...  
a detachable storage media installable in said client console, said detachable storage media having a media identifier, wherein the media identifier is combined with the user specific information to define a user identifier, the user identifier is uploaded to said download management server to enable access only to a specified content in said primary media content database, said specified content and said user information is downloaded to said client console, the specified content being associated with billing trigger data to enable monitoring of when specific portions of the specified content is accessed for use at said client console, the monitoring being configured to generate a record of used content, the record of used content being communicated back to the management server to record a revenue bearing event in the customer database.

**Argument:**

As can be read from the language of claim 1, the detachable storage media is installable in said client console. The detachable storage media has a media identifier, which is combined with the user specific information. The user identifier is then uploaded to the download management server. This claimed process then enables access only to a specified content in the primary media content database.

Support for this claimed process is found in the specification in several locations.

To define the meaning of the detachable storage media, reference should be made to page 10, lines 18-23 extending to page 11, lines 1-22. On page 12, lines 17-22

extending to page 13, lines 1-2, further information regarding the use of the detachable storage media 122 is provided.

On page 14, lines 3-12, a definition is provided regarding the unique media ID. For a first time user, the unique media ID is *associated* with the user and is thereafter used as a user identifier. If it is not a first time user, the media ID is sent to the download service management server 102.

On page 17, lines 8-20, it is noted that the media ID, once associated with the user information serves as a user identifier.

On page 17, lines 21-23 and page 18, lines 1-11, it is noted that once the media ID is uploaded to the server, based on the media ID, the server 102 can determine which primary content, from among multiple contents in the content database 106, are authorized for access to the user, on the basis of the user identifier. Thus, access to... "a specified primary content from among multiple contents in the in the contents database..." is provided.

On page 20, lines 2-9, it is noted that "the desired primary content may have attached thereto certain user information that is associated with the user ID from the customer database 104. "As for determining which primary content is authorized and hence downloadable to a given user, the user may be presented with a menu option which displays "only" those primary content items, from among all items contained in the contents database 106, that are authorized to the user for downloading and viewing thereby facilitating selection by the user."

The Applicant points out that this rejection has been repeated in past Office Actions, and the Applicant has repeatedly pointed the Examiner to various sections in the as-filed Specification for support. The claim language at issue is found in the excerpt of claim 1 provided above, and the Board has been provided with various sections in the as-

filed Specification which support the claim language. There is no inconsistency between what is claimed and what is disclosed.

Most importantly, the Examiner has repeatedly indicated his confusion with how the "specified content" is identified among all of the contents in the contents database. As noted from the cited pages above, the media ID is associated with the user information to define a user identifier. This combined information is used to enable access to only a specified content in said primary media content database. The term "only" in claim 1, is used to make clear that "only" *a specified content* is capable of being accessed, among all of the content on the primary media content database. A specified content can be one content, or multiple contents, from among all of the content on the primary media. As noted above from the specification, it is clear that the media ID will provide the information that is needed to identify only a specified content. The word "only" is also supported by the specification, and the Office is again referred to page 20, lines 2-9. Although this is plain English, it is noted that enabling access to only a specified content will provide access to a subset of all of the contents on the primary media content database. The application as-filed also provides support for the use of the term "subset", for identifying which content among all of the content on the primary media content database is accessible to the user. See page 15, lines 21-22.

In view of the foregoing, it is respectfully submitted that the defined claim language is clear, supported by the as-filed specification, and will not present confusion. The claim language is also fully correlated to the as-filed specification, and the Applicant respectfully requests the Board to reverse the Examiner on this rejection.

**B. The claimed invention is not indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention, as recited in claims 9-12 and 17-24 (Group II).**

**Rejection:**

Claims 9-12 and 17-24 were rejected as being indefinite, under the second paragraph of Section 112. The Examiner notes that the language "... specified content of the primary media content ..." is not clear because the Examiner does not understand how the specified content is identified within the primary media content database. See Advisory Action dated Aug. 17, 2004.

**The Claim language:**

Language of Claim 9.

... transmitting user identifier including a media ID of the detachable storage media and user information along with a request for a specified content of the primary media content to said download management server, in order to retrieve said specified content from a contents database, the specified content being a subset of data stored in contents database, the subset being defined by the media ID...

Language of Claim 17.

...communicating a request from the client computer to a content provider for a specified content, the request including a media ID of a detachable media and user information, the media ID and the user information defining a user identifier, the specified content being a subset of data stored by the content provider, the subset being defined by the media ID...

Language of Claim 20.

...program instructions for communicating a request from the client computer to a content provider for a specified content, the request including a media ID of a detachable media and user information, the media ID and the user information defining a user identifier, the specified content being a subset of data stored by the content provider, the subset being defined by the media ID...

**Argument:**

As can be read from the language of claims 9, 17 and 20, the specified content is the content from the primary media content database. The specified content is a subset of

data stored on the content database or content provider. Then, the specified content is identified by the media ID. The plain language in the claims themselves define "how" the specified content is identified. The comments in by the Examiner in the Advisory Action dated Aug. 17, 2004, are not comprehensible to the Applicant. The Examiner has characterized the invention in ways that are counter to what is disclosed in the as-filed application. The examples and suggestions provided by the Examiner in the Advisory Action are simply not directed to the claimed invention, and thus, the Applicant respectfully disagrees with the Examiner's comments. A complete reading of the specification as-filed, will show that the Examiner's understanding is not correct and the discussion provided in the Advisory Action is simply not related to the present application.

The Board is kindly requested to read the complete application and the pages cited herein to see how the Examiner's understanding of the specification is not correct.

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). When the specification provides definitions for terms appearing in the claims, the specification can be used in interpreting claim language. *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). "Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'." 710 F.2d at 802, 218 USPQ at 292 (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original).

In view of the foregoing, it is respectfully submitted that the defined claim language is clear, supported by the as-filed specification, and will not present confusion. The claim language is also fully correlated to the as-filed specification, and the Applicant respectfully requests the Board to reverse the Examiner on this rejection.

**C. The references relied upon by the Examiner, either separately or in combination, do not motivate or suggest to one of ordinary skill in the art at the time of the invention to combine the reference teachings in a manner that would make the invention as recited in Claims 1-8 (Group I) obvious.**

Claims 1-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,619,247 to James Russo (Russo) in view of U.S. Patent No. 5,530,754 to Norton Garfinkle (Garfinkle), in view of U.S. Patent No. 5,857,020 to Mendel Lazear Peterson Jr., and in view of 5,063,547 to Pieter H. Custer (Custer).

For the following reasons, the Board is respectfully requested to reverse the Examiner's rejection, as the cited art fails to suggest the claimed invention, does not combine to teach or suggest the claimed invention, and fails to suggest each element of the claimed invention of Group I.

Claim 1, is provided for ease of reference:

Claim 1. A system for providing access to primary media content in digital form, comprising:

a server network comprising a download management server, a customer database storing user information, and a primary content database storing primary media content;

a client console connectable for establishing a communications link through a bi-directional communications network to said download management server, the client console storing user specific information;

a detachable storage media installable in said client console, said detachable storage media having a media identifier, wherein the media

identifier is combined with the user specific information to define a user identifier, the user identifier is uploaded to said download management server to enable access only to a specified content in said primary media content database, said specified content and said user information is downloaded to said client console, the specified content being associated with billing trigger data to enable monitoring of when specific portions of the specified content is accessed for use at said client console, the monitoring being configured to generate a record of used content, the record of used content being communicated back to the management server to record a revenue bearing event in the customer database.

Although each element should be considered by the Board, specific emphasis will be made with regard to elements of the claim which are not taught nor suggested by the combined references. For example, the media identifier is *combined* with the user specific information to define a *user identifier*. This combination is not taught nor suggested by the art of record. The claim also specifically recites that the "specified content" is associated with "billing trigger data." The billing trigger data, as shown in Figure 4 of Applicant's specification, is associated with the content 415. As defined in the claim, the billing trigger data is used to enable monitoring of the what specific portions of the specified content is accessed for use at the client console. Thus, a billing event does not occur when the content is downloaded, but alternatively, the billing trigger data sits with the content (without billing the user) until access for use has occurred at the client console. Once access is completed or use has been established, billing usage is communicated back to the server (e.g., management server) to record the revenue bearing event in the customer database.

The Examiner has maintained Russo and Garfinkle as primary references to hold the rejection. Additional references have also been added to individually show other elements of the claim. However, it is respectfully noted that these combined references not only fail to combine, but in fact, when combined, do not teach or suggest what is being

claimed. This argument has been made in repeated Office Action responses, and each time, the Examiner has not addressed the Applicant's argument and has failed to specifically state "*why*" the art teaches or suggest each element.

In response to the Applicant's arguments, the Examiner in the Office Action dated April 7, 2004, page 2, noted that the "[t]he Applicant's arguments with respect to claims 1 and 9 have been considered but are moot in view of the new ground(s) of rejection." The Board's attention is drawn to the fact that the Examiner maintained the same primary references of Russo, Garfinkle, and Custer, while only adding a fourth reference to Peterson. The addition of a single new reference, when the Examiner continues to rely on the same original references, does not render the Applicant's arguments moot. Furthermore, the Office Action does not provide reasoning nor examples of motivation to combine. The simple recitation of citations after each claim element does not provide objection reasoning of *how* one of ordinary skill in the art would be motivated to combine the cited art to arrive at the claimed invention.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. MPEP §2143.01 However, the level of ordinary skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). A statement that modifications of the prior art to meet the claimed invention would



have been within the ordinary skill of the art at the time the claimed invention was made is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

The Office Actions have, respectfully speaking, been lacking in any substantive reasoning. Although many citations have been provided, simple laundry lists of elements has not provided the Applicant with an understanding of the Office's reasons or how the Office views the art and how it could be combined.

For completeness, the Applicant will show how the cited art is lacking in teaching or suggestion to render the claimed invention obvious.

In Russo, the goal is to provide "pay-per-view" capability to users of a service (similar to commercially available TiVo Services). Content can be selected and then downloaded to the play/record controller. The nature of "pay-per-view" systems which are typically offered by cable television companies is that the content is limited to available content being broadcasted during a particular period of time. The users, according to Russo can then select particular programs from an index of programs that may be available now or may be available in the future. The user can then make his or her selection and the system will record the selected programming when it becomes available. Unlike the present invention, which does not depend on a broadcasted signal to obtain content, the users of Russo must rely on "recording" of data for later viewing.

Although Russo talks about downloading a particular tune for immediate reception, the user is allowed to access the tune through a multi-channel source. Col. 7, lines 15-22. However, downloading immediately depends on whether the multi-channel source is actually broadcasting the tune at that time. To ascertain when particular programming will be available, the user will be required to look to a schedule, which is updated to schedule memory 136 from time to time. Refer also to Col. 9, lines 60-67, where Russo says that **"In most cases, a user may be given a list of titles available, from which to make direct choices."** In Russo, therefore, the use would be allowed to scroll through a list of titles of previously stored programs, and then select programs to view. Col. 10, lines 54-66. As apparent from the teachings of Russo, a user is restricted to accessing data based on whether data is being broadcasted, and therefore, Russo teaches recording such programs automatically for the user for later viewing. As the user is not necessarily viewing the programming when downloading is occurring, Russo teaches only billing the user when the program is used.

The Examiner points to Garfinkle to teach an association between an "end user" and "content." Specifically, the Examiner points to Col. 4, lines 2-6 and 59-65. Garfinkle teaches sending identifier data for the desired product and a site identifier. However, Garfinkle *does not* associate a media identifier with user information to define a user identifier. This association is not the same, and Garfinkle does not teach linking a media ID of a detachable media with a user. **In addition, Garfinkle also teaches that the user is "billed" when the product is downloaded.** This teaching contradicts the teachings of Russo. However, because Garfinkle teaches on-demand video, the user necessarily *must* be billed when the download is complete.

With the teachings of the main prior art references in mind, and noting that such references conflict in their teachings, one of skill in the art looking at Russo would not necessarily be motivated to look to Garfinkle, since a main objective of Garfinkle is to not bill until the product is actually viewed. Consequently, it is not possible to suggest that their teachings are combinable when, in fact, they contradict each other.

Referring to the claimed invention, the claims require a detachable storage media having a media identifier. From the Applicant's examination of the cited art, there is no mention that a detachable storage media be provided. In fact, Russo relies on its proprietary system to control the navigation, and the system already has a pre-established account with the content provider. In contrast, in the claimed invention, there is no need for a system to already be in established contact with a provider. By simply inputting the detachable storage media, a communication link is established with a download management server. The same detachable storage media can therefore be installed into any system, not necessarily the system of a particular subscriber. Thus, before communication to obtain content is initiated, the "media identifier" and the "user specific information" are combined. As claimed, once combined, a user identifier is defined. The user identifier can then, after the combination, be used to access specified content in the primary media database. But, only the specified content is accessible, not the entire content of the primary content database. When the specified content is returned to the user, the user identifier is sent back with the specified content. In accordance with the claims, the specified content is associated with billing trigger data, as mentioned above.

It is respectfully submitted that neither Russo, nor the associated secondary references teach the coupling of the "detachable storage media" having an media ID, with

user information to form a "*user identifier*." The user identifier is then, as claimed, transmitted to the download management sever when a "request" is made for content, and then the content is returned back to the user with the same "user identifier." However, when returned, the content *also includes the billing trigger data*.

As mentioned above, although the Applicant noted the non-combinability of the cited art, the Examiner added a fourth reference and declared all previous arguments moot. The fourth secondary reference is Peterson Jr. The resulting rejection under 35 USC §103(a) includes U.S. Patent No. 5,619,247 to James Russo (Russo) in view of U.S. Patent No. 5,530,754 to Norton Garfinkle (Garfinkle), in view of U.S. Patent No. 5,857,020 to Mendel Lazear Peterson Jr., and in view of 5,063,547 to Pieter H. Custer (Custer).

Peterson Jr. is concerned with the making of particular media available to users at a specific time. The specific time is set in advance, and that time is referred to as the "premier" time. Before the premier time, customers can register to get access to the media. At later times, the customers can view the same media on a "pay-per-use" schedule. As is evident from the narrow teachings of Peterson Jr., the only way a user can gain access to the media is to wait for some premier date and time. This is contrary to claims of the present invention. There simply is no premier date/time limitation associated with the functionality defined by the claims. Consequently, Peterson Jr. does not add to the motivation, nor does Peterson Jr. overcome the deficiencies of Russo, Garfinkle, and Custer. In fact, Peterson Jr. contradicts the claimed invention.

The rationale for combining references requires a recognition either expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on

established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by the combination of references. *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). The Applicants respectfully submit that the references neither expressly nor implicitly provide the motivation to combine their respective teachings as suggested by the Examiner.

More importantly, to establish a prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The art simply does not suggest all of the limitations, and to the contrary, the art actually contradicts elements of the claimed invention.

For at least the foregoing reasons, the Board is respectfully requested to withdraw the Section 103 rejections of the claims of Group I.

**D. The references relied upon by the Examiner, either separately or in combination, do not motivate or suggest to one of ordinary skill in the art at the time of the invention to combine the reference teachings in a manner that would make the invention as recited in Claims 9-12 and 17-24 (Group II) obvious.**

Claims 9-12 and 17-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,619,247 to James Russo (Russo) in view of U.S. Patent No. 5,857,020 to Mendel Lazear Peterson Jr., and in view of 5,063,547 to Pieter H. Custer (Custer).

For the following reasons and also those noted in Section C, the Board is respectfully requested to reverse the Examiner's rejection, as the cited art fails to suggest the claimed invention, does not combine to teach or suggest the claimed invention, and fails to suggest each element of the claimed invention of Group II.

The Board is kindly referred directly to independent claims 9, 17 and 20. It is emphasized that each independent claim should be examined independently.

As mentioned above, Russo's goal is to provide "pay-per-view" capability to users of a service. The nature of "pay-per-view" systems which are typically offered by cable television companies is that the content is limited to available content being broadcasted during a particular period of time. Unlike the present invention, which does not depend on a broadcasted signal to obtain content, the users of Russo must rely on "recording" of data for later viewing.

In the claimed invention, a communications link is established between a client console and a download management server through said bi-directional communications network. The client console has a detachable storage media detachably installed therein. A user identifier is transmitted including a media ID of the detachable storage media and user information along with a request for a specified content of the primary media content to said download management server in order to retrieve the specified content from a contents database. The specified content is a subset of data stored in contents database, and the subset being defined by the media ID. Then, the downloading is enabled. Thus downloading to said client console from

said download management server said specified content, said specified content is provided with associated billing trigger data.

These teachings are simply lacking. It is not possible to logically state that a teaching of Russo, which requires users to wait until a specific time in the future is the same or would suggest enabling access when the user initiates the computer processes defined in claims 9, 17 and 20. Peterson Jr. and Custer then, further cement the contradictory teachings of the cited art that require the user to wait for some premier date and time.

It is further noted that there is no teaching or suggestion in the art that point one of skill in the art to use a detachable storage media to identify or use the media ID to enable access to only those specified content from a primary contents database upon executing the claimed process. Throughout the Office Action dated April 7, 2004, the Examiner points to individual citation locations in the art, but fails to specify why or how those teachings render the claimed invention of Group II obvious.

The Examiner has also noted that "[t]hough, Russo, Garfinkle and Peterson **are not specific about the specifics** of the identifications data transmitted between the client console and the central server." (emphasis added). See Page 5 of the April 7, 2004 Office Action. Thus, the Examiner concedes that the references are not specific about specifics. Without being specific about specifics, the Applicant's insist that the rejections fail to rise to a proper Section 103 rejection.

The Examiner continues by Citing to Custer, noting "However, Custer is clear on how to achieve a better relations among preferred selection of content and making the identification of data associated with both specific end user as well as to an specific content by combining the user specific information and the specific content information to create an ID... (cite to Custer)." (grammar errors, original to Office Action). Further, the Examiner notes in the same paragraph of Page 5, that "In addition this method of creating specific identifiers based on combining user specific information and medium or content identifiers to arrive at an specific identifier is well known in the art." The Applicant respectfully disagrees. It is not proper to make a blanket statement of what is well known, without providing some teachings from the art or support therefore. The art, simply does not teach or suggest that which the Examiner asserts is taught, and in fact, the teachings are contradictory. If it is so well known, then the Applicant's respectfully make of record that the cited art does not support such statement.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. MPEP §2143.01 However, the level of ordinary skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). A statement that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art at the time



the claimed invention was made is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.

*Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

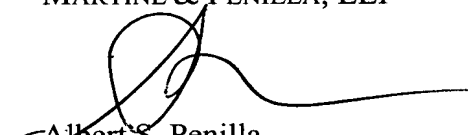
For at least the foregoing reasons, the Board is respectfully requested to withdraw the Section 103 rejections of the claims of Group II.

**E. Conclusion**

The Applicants respectfully request that the Board consider each group of claims separately. The Applicants further respectfully request that the Board consider the elements of each claim as a whole relative to the teachings of the cited art.

In sum, the Applicants submit that the rejections of the Group I and Group II under 35 USC § 112, second paragraph and under 35 U.S.C. §103(a) are in error, and respectfully request that the Board of Appeals and Interferences reverse the Examiner's rejections of the claims on appeal.

Respectfully Submitted,  
MARTINE & PENILLA, LLP



Albert S. Penilla  
Reg. No. 39,487

MARTINE & PENILLA, LLP  
710 Lakeway Drive, Suite 170  
Sunnyvale, California 94085  
408.749.6900

**APPENDIX A**

**CLAIMS ON APPEAL**

Claim 1. A system for providing access to primary media content in digital form, comprising:

a server network comprising a download management server, a customer database storing user information, and a primary content database storing primary media content;

a client console connectable for establishing a communications link through a bi-directional communications network to said download management server, the client console storing user specific information;

a detachable storage media installable in said client console, said detachable storage media having a media identifier, wherein the media identifier is combined with the user specific information to define a user identifier, the user identifier is uploaded to said download management server to enable access only to a specified content in said primary media content database, said specified content and said user information is downloaded to said client console, the specified content being associated with billing trigger data to enable monitoring of when specific portions of the specified content is accessed for use at said client console, the monitoring being configured to generate a record of used content, the record of used content being communicated back to the management server to record a revenue bearing event in the customer database.

Claim 2. The system according to claim 1, wherein said user identifier comprises an alphanumeric media ID identifying said detachable storage media, said alphanumeric media ID defining a level of access available when accessing the primary media content database.

Claim 3. The system according to claim 2, wherein said specified content comprises a portion of an overall set of primary contents stored in said contents database, and wherein said media ID serves to limit access to particular ones of the overall set of primary contents of the specified content.

Claim 4. The system according to claim 1, wherein said specified content is associated with an authentication code for authenticating access to the download management server.

Claim 5. The system according to claim 4, wherein said specified content comprises a portion of an overall set of primary contents stored in said contents database, and wherein said authentication code authenticates access to the download management server which is responsible for providing access to said specified content.

Claim 6. The system according to claim 1, wherein each portion of the specified content is associated with respective billing trigger data, the billing trigger data tracks usage to generate a usage history of the primary media content in the customer database.

Claim 7. The system according to claim 6, wherein said detachable storage media includes a program for providing network access and a code which causes execution of a program stored in said media console for providing network access.

Claim 8. The system according to claim 1, wherein said client console further comprises a local fixed storage device disposed internally or externally of said client console, wherein said specified content is downloaded only to said fixed storage device.

Claim 9. A method for delivery of primary media content in digital form through a bi-directional communications network, comprising the steps of:

establishing a communications link between a client console and a download management server through said bi-directional communications network, said client console having a detachable storage media detachably installed therein;

transmitting user identifier including a media ID of the detachable storage media and user information along with a request for a specified content of the primary media content to said download management server, in order to retrieve said specified content from a contents database, the specified content being a subset of data stored in contents database, the subset being defined by the media ID;

downloading to said client console from said download management server said specified content, said specified content being provided with associated billing trigger data;

recording usage of the specified content at the client console using the associated billing trigger data;

transferring the recorded usage of the specified content back to the download management server; and

charging only for portion of the specified content used at the client console.

Claim 10. The method according to claim 9, wherein said media ID identifies said detachable storage media, further comprising the step of receiving said media ID and an authentication code from said client console at said download management server, wherein one of said authentication code and said media ID serves to limit access to particular portions of said primary media content.

Claim 11. The method according to claim 9, wherein the billing trigger data assists in compiling usage information of the specified content in a customer database.

Claim 12. The method according to claim 9, wherein said step of downloading to said client console from said download management server comprises storing said specified content on a local fixed storage device disposed internally or externally of said client console.

Claims 13 - 16 (Cancelled)

Claim 17. A method for obtaining media content at a client computer, comprising:

communicating a request from the client computer to a content provider for a specified content, the request including a media ID of a detachable media and user information, the media ID and the user information defining a user identifier, the specified

content being a subset of data stored by the content provider, the subset being defined by the media ID;

downloading the specified content to the client computer, the specified content being associated with billing triggering data, the billing triggering data being configured to assist in tracking when portions of the specified content is used at the client computer; and

returning information regarding the tracked usage of the portions of the specified content to the content provider.

Claim 18. A method for obtaining media content at a client computer as recited in claim 17, wherein the tracked usage is associated with the user information to enable billing for the usage of the portions of the specified content.

Claim 19. A method for obtaining media content at a client computer as recited in claim 17, wherein the specified content is downloaded to the client computer, but billing for the downloaded specified content is not triggered until usage of at least a portion of the specified content at the client computer.

Claim 20. Computer readable media having program instructions for enabling the obtaining of media content at a client computer, the computer readable media comprising:

program instructions for communicating a request from the client computer to a content provider for a specified content, the request including a media ID of a detachable media and user information, the media ID and the user information defining a user

identifier, the specified content being a subset of data stored by the content provider, the subset being defined by the media ID;

program instructions for triggering downloading the specified content to the client computer, the specified content being associated with billing triggering data, the billing triggering data being configured to assist in tracking when portions of the specified content is used at the client computer; and

program instructions for sending information regarding the tracked usage of the portions of the specified content to the content provider.

Claim 21. Computer readable media having program instructions for enabling the obtaining of media content at a client computer as recited in claim 20, wherein the tracked usage is associated with the user information to enable billing for the usage of the portions of the specified content.

Claim 22. Computer readable media having program instructions for enabling the obtaining of media content at a client computer as recited in claim 20, wherein the specified content is downloaded to the client computer, but billing for the downloaded specified content is not triggered until usage of at least a portion of the specified content at the client computer.

Claim 23. Computer readable media having program instructions for enabling the obtaining of media content at a client computer as recited in claim 22, wherein the computer readable media is packaged media.



Claim 24. Computer readable media having program instructions for enabling the obtaining of media content at a client computer as recited in claim 23, wherein the packaged media is a compact disc.